

DOCKET NO.: 230172US0

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION OF :
VALERIE DE LA POTERIE, ET AL. : EXAMINER: VENKAT, JYOTHSNA
SERIAL NO: 10/656,201 :
FILED: SEPTEMBER 8, 2003 : GROUP ART UNIT: 1615
FOR: COSMETIC KERATIN FIBRE
CARE OR MAKEUP COMPOSITION :

REQUEST FOR RECONSIDERATION

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

SIR:

In response to the Office Action dated August 28, 2007, reconsideration and allowance are respectfully requested in view of the following remarks.

Claims 36-68 are pending, claims 45-49 and 66-68 having been withdrawn from consideration.

Withdrawn Claims

For the reasons set forth below, Applicants submit that all pending claims presently subject to examination are in condition for allowance. Because each of the withdrawn claims depends from, and thus recite all features of, an allowable claim subject to examination, rejoinder and allowance of the withdrawn claims are respectfully requested.

Rejection Under 35 U.S.C. §112, Second Paragraph

The Office Action rejects claims 36-38 as indefinite under 35 U.S.C. §112, second paragraph. Applicants respectfully traverse the rejection.

The Office Action asserts that the recitation of "dry solids extract" in claims 36-38 renders those claims indefinite. At the outset, Applicants submit that one of ordinary skill in the art would be well aware of the meaning of "dry solids extract." Further, the present specification sets forth a detailed, exemplary protocol by which "dry solids extract" can be determined. *See* present specification, page 32, lines 12 to 24. A skilled artisan, taking his own knowledge and the detailed description set forth in the present specification, could readily determine whether a composition falls within or outside of the scope of claims 36-38. Accordingly, the metes and bounds of claims 36-38 are clear. *See* MPEP §2173.02.

For the foregoing reasons, claims 36-38 are definite. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Rejection Under 35 U.S.C. §102

A. De La Poterie 020

The Office Action rejects claims 36-44 and 50-65 under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. US 2004/0137020 A1 to De La Poterie et al. ("De La Poterie 020"). Applicants respectfully traverse the rejection.

De La Poterie 020 was filed on September 5, 2003 and claims priority benefit of provisional applications having filing dates as early as September 24, 2002. The present application was filed on September 8, 2003, and claims priority to French Patent Application No. 02 11098, filed September 6, 2002. As is evident from the English-language translation filed herewith, the disclosure of French Patent Application No. 02 11098 fully supports the claims of the present application. Accordingly, the claims of the present application are

entitled to the September 6, 2002 filing date of French Patent Application No. 02 11098. De La Poterie 020 and the provisional applications to which De La Poterie 020 claims priority were filed after the September 6, 2002 priority filing date of the present application, and thus De La Poterie 020 is not available as prior art against the claims of the present application under 35 U.S.C. §102(e). As De La Poterie 020 is not available as prior art against the claims of present application under 35 U.S.C. §102(e), the rejection over De La Poterie 020 should be withdrawn.

De La Poterie 020 also cannot be applied against the present claims in an obviousness rejection pursuant to 35 U.S.C. §103(c). De La Poterie 020 is only potentially available as prior art against the present application under 35 U.S.C. §102(f) or (g). De La Poterie 020 is not available as prior art under 35 U.S.C. §102(a) because De La Poterie 020 was published on July 15, 2004, which is after the September 8, 2003 filing date of the present application. De La Poterie 020 is not available as prior art under 35 U.S.C. §102(b) because the July 15, 2004 publication date of De La Poterie 020 is after the September 8, 2003 filing date of the present application. The presently claimed invention and the subject matter disclosed in De La Poterie 020 were owned and/or subject to an obligation of assignment to L'Oreal at the time the presently claimed invention was made. *See Assignment relating to De La Poterie 020 at Reel 015133, Frame 0462; see Assignment relating to present application at Reel 015840, Frame 0867.*

As De La Poterie 020 is only potentially available as prior art against the present application under 35 U.S.C. §102(f) or (g), and the subject matter disclosed in De La Poterie 020 and the presently claimed invention were owned and/or subject to an obligation of assignment to the same entity at the time the presently claimed invention was made, De La Poterie 020 cannot form the basis of an obviousness rejection pursuant to 35 U.S.C. §103(c).

For the foregoing reasons, reconsideration and withdrawal of the rejection are respectfully requested.

B. De La Poterie 021

The Office Action rejects claims 36-44 and 50-65 under 35 U.S.C. §102(e) over U.S. Patent Application Publication No. US 2004/0137021 A1 to De La Poterie et al. ("De La Poterie 021"). Applicants respectfully traverse the rejection.

De La Poterie 021 was filed on September 5, 2003 and claims priority benefit of provisional applications having filing dates as early as September 24, 2002. The present application was filed on September 8, 2003, and claims priority to French Patent Application No. 02 11098, filed September 6, 2002. As is evident from the English-language translation filed herewith, the disclosure of French Patent Application No. 02 11098 fully supports the claims of the present application. Accordingly, the claims of the present application are entitled to the September 6, 2002 filing date of French Patent Application No. 02 11098. De La Poterie 021 and the provisional applications to which De La Poterie 021 claims priority were filed after the September 6, 2002 priority filing date of the present application, and thus De La Poterie 021 is not available as prior art against the claims of the present application under 35 U.S.C. §102(e). As De La Poterie 021 is not available as prior art against the claims of present application under 35 U.S.C. §102(e), the rejection over De La Poterie 021 should be withdrawn.

De La Poterie 021 also cannot be applied against the present claims in an obviousness rejection pursuant to 35 U.S.C. §103(c). De La Poterie 021 is only potentially available as prior art against the present application under 35 U.S.C. §102(f) or (g). De La Poterie 021 is not available as prior art under 35 U.S.C. §102(a) because De La Poterie 021 was published on July 15, 2004, which is after the September 8, 2003 filing date of the present application.

De La Poterie 021 is not available as prior art under 35 U.S.C. §102(b) because the July 15, 2004 publication date of De La Poterie 021 is after the September 8, 2003 filing date of the present application. The presently claimed invention and the subject matter disclosed in De La Poterie 021 were owned and/or subject to an obligation of assignment to L'Oreal at the time the presently claimed invention was made. *See Assignment relating to De La Poterie 021 at Reel 015149, Frame 0519; see Assignment relating to present application at Reel 015840, Frame 0867.*

As De La Poterie 021 is only potentially available as prior art against the present application under 35 U.S.C. §102(f) or (g), and the subject matter disclosed in De La Poterie 021 and the presently claimed invention were owned and/or subject to an obligation of assignment to the same entity at the time the presently claimed invention was made, De La Poterie 021 cannot form the basis of an obviousness rejection pursuant to 35 U.S.C. §103(c).

For the foregoing reasons, reconsideration and withdrawal of the rejection are respectfully requested.

Double Patenting

The Office Action provisionally rejects claims 36-44 and 50-65 under 35 U.S.C. §101 and under the judicially created doctrine of obviousness-type double patenting over claims 32-38 and 45-58 of U.S. Patent Application No. 10/656,278. Applicants submit that the Terminal Disclaimer filed herewith obviates the rejection. Accordingly, reconsideration and withdrawal of the rejection are respectfully requested.

Conclusion

For the foregoing reasons, Applicants submit that claims 36-68 are in condition for allowance. Prompt reconsideration and allowance are respectfully requested.

Respectfully submitted,

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Attachments:

English-language Translation of French Patent Application No. 02 11098
Terminal Disclaimer